

REMARKS

Favorable reconsideration of this application, in view of the present amendments and in light of the following discussion, is respectfully requested.

Claims 1-8 and 31-46 are pending and amended. Claims 9-30 having been withdrawn from consideration are canceled without prejudice or disclaimer. No new matter is introduced.

In the outstanding Office Action, Claims 2, 4, 6, 8, 34-36, 39-40, 43 and 46 were rejected under 35 U.S.C. § 101; Claims 1-8 and 31-46 were rejected under 35 U.S.C. § 112, first paragraph; Claims 2, 4, 6 and 8 were rejected under 35 U.S.C. § 112, second paragraph; and Claims 1-8 and 31-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Narasimhan (U.S. Patent No. 6,073,165, hereafter Narasimhan) in view of Moon (U.S. Patent No. 6,138,146, hereafter Moon).

With respect to the rejection of Claims 2, 4, 6, 8, together with their corresponding dependent claims, as being directed to non-statutory subject matter, Claims 2, 4, 6 and 8 are system claims including such features as a server computer. Moreover, it is noted that computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed **as part of an otherwise statutory manufacture or machine**. In such a case, the claim **remains statutory irrespective of the fact that a computer program is included in a claim**.¹ Therefore, it is submitted that Claims 2, 4, 6 and 8 comply with the requirements of 35 U.S.C. § 101. Claims 34-36 and 39-40 and 43 and 46 also comply with the requirements of 35 U.S.C. § 101 through their dependency on Claims 2, 4, 6 and 8, respectively. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 101 of Claims 2, 4, 6, 8, 34-36, 39-40, 43 and 46 be withdrawn.

¹ See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, USPTO 2005 (Annex IV, computer related non-statutory subject matter) page 53.

With regard to the rejection of Claims 1-8 and 31-46 under 35 U.S.C. § 112, first paragraph, the “forwarding the forwarded information to a remote device” feature is deleted in Claims 1-2, 4-8, rendering the rejection moot with regard to these claims. Further, Claim 3 has been amended to recite “forwarding the information stored in the datastore associated with the server computer to an *appropriate client personal computer*” for which the specification provides support. Therefore, it is submitted that Claims 1-8, together with their corresponding dependent claims, comply with the requirements of 35 U.S.C. § 112, first paragraph, and it is respectfully requested that the rejection of Claims 1-8 and 31-46 under this section be withdrawn.

Regarding the rejection of Claims 2, 4, 6 and 8 under 35 U.S.C. § 112, second paragraph, the informalities identified in the outstanding Office Action correspond to the deleted portions of Claims 2, 6 and 8. Further, Claim 4 is amended to comply with the requirements of 35 U.S.C. § 112, second paragraph. Therefore, it is respectfully requested that the rejection of Claims 2, 4, 6 and 8 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Turning to the rejection of Claims 1-8 and 31-46 as being unpatentable over Narasimhan in view of Moon, Claim 1 is amended to recite in part an email forwarding method that includes:

comparing the start criteria stored in the client personal computer with a start criteria stored on the server; and
synchronizing the start criteria stored on the client personal computer and the start criteria stored on the server when a difference is detected therebetween.

The applied reference, Narasimhan describes a message processing and forwarding system that receives messages over a computer communication network, and, after processing the messages, forwards them to a receiver.² Specifically, Narasimhan describes

² Narasimhan at column 1, lines 39-43.

that an original message is received at a source server (105),³ and that the computer network routing information and message filter parameters are determined in order to create a filtered message that can be routed to a destination message server.⁴ However, Narasimhan does not describe that separate copies of the computer network routing information or the message filter parameters are stored in both the source server (105) and the receiver, much less that both the server copies and the receiver copies are synchronized when a difference is detected therebetween. Therefore, Narasimhan fails to disclose or suggest the claimed “comparing the start criteria stored on the client personal computer with start criteria stored on the server,” or the claimed “synchronizing the start criteria stored on the client personal computer and the start criteria stored on the server when a difference is detected between the start criteria of the client personal computer and the start criteria of the server.”

Further, the outstanding Office Action combines Narasimhan with Moon, which describes a mail forwarding system for retrieving e-mail stored on a private server (16) in a private network system (12) by a remote communicator (30).⁵ Moon also describes that the system includes a mail forwarding program (32) operating on a fixed computer (20), and that a user can enter parameters and routings into the mail forwarding program (32).⁶ However, Moon describes that the user-defined parameters and routings can only be entered in the fixed computer (20),⁷ and does not describe that these parameters are compared or synchronized with data stored in any other part of the private network. Therefore, Moon also fails to disclose or suggest the claimed “comparing the start criteria stored on the client personal computer with start criteria stored on the server” and the claimed “synchronizing the start criteria stored on client personal computer and the start criteria stored on the server.” As such Moon does not cure the deficiencies identified in Narasimhan, and no combination of

³ Narasimhan at column 3, line 66-column 4, line 20; see also Figure 2.

⁴ Narasimhan at column 4, line 42-column 5, line 50.

⁵ Moon at column 5, lines 64-67; see also Figure 1.

⁶ Moon at column 6, lines 1 - 10.

⁷ Moon at column 6, lines 5-10.


Narasimhan and Moon describes every feature recited in amended Claim 1. Therefore, amended Claim 1, together with its corresponding dependent claims, is in condition for allowance.

Moreover, amended Claims 2-8 recite substantially similar features as those recited in amended Claim 1, and are therefore in condition for allowance, together with their respective dependent claims, for substantially the same reasons. Accordingly, it is respectfully requested that the rejection of Claims 1-8 and 31-46 under 35 U.S.C. § 103(a) be withdrawn.

For the reasons discussed above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance for Claims 1-8 and 31-46 is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Scott A. McKeown
Attorney of Record
Registration No. 42,866

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)